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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Sture Roos

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2176

7590

12/28/2004

NIXON & VANDERHYE P.C.

8th Floor

1100 North Glebe Road

Arlington, VA 22201-4714

EXAMINER

ZHENG, EVA Y

ART UNIT

PAPER NUMBER

2634

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/732,879

Applicant(s)

ROOS ET AL.

Examiner

Eva Yi Zheng

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Applicant's arguments with respect to claims 20-34 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Claim Objections

3. Claim 21 is objected to because of the following informalities: on line 8, recitation: "first xDSL modems" should be changed to -- first xDSL modem --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 20-22, 24-28 and 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by McHale et al. (US 6,385,203 B2).

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a) Regarding claim 20, McHale et al. disclose a method in a telecommunication system for providing access to telecommunication services to subscribers at user terminals (12 in Fig. 1), each of which being separately connected to at least one access point, via a net terminal including an xDSL modems (30 in Fig. 1), and a communication network, the at least one access point comprising xDSL modems (30 in Fig. 1) with filters (170 in Fig. 5), comprising:

transmitting a signal from an in-band modem of the net terminal (24 in Fig. 1) including a user terminal identity to a controller (80 in Fig. 2; Col 8, L11-20);

in response, the controller searching for an available connection path for the net terminal at an access point (Col 8, L 21-31; Col 9, L 18-50; and Col 12, L 3-25);

Creating, by the controller, a bi-directional broadband data transmission path between the user terminal and the at least one access point using the in-band modem connection of the net terminal for initial installation of the broadband data transmission path (Col 6, L45-47; and Col 9, L25-30); and

Activating, by the controller, the transmission path between the user terminal and the at least one access point (Col 8, L 21-31; and Col 12, L7-25).

b) Regarding claim 21, McHale et al. disclose an apparatus for use in a telecommunication system for providing access to telecommunication service to subscribers, comprising:

plural subscriber user terminals (12 in Fig. 1);

plural net terminals (24 in Fig. 1), each user terminal being coupled to one of the net terminals, and each net terminal including an in-band modem and a first xDSL modem (30 in Fig. 1);

a first access point coupled to plural ones of the net terminals and including a pool of second xDSL modems (74 in Fig. 2);

a controller (80 in Fig. 2) coupled to the access point and configured to control the first xDSL modems and the second xDSL modems to establish a bi-directional broadband connection between one of the user terminals and access point (Col 6, L45-47; and Col 9, L18-30),

wherein prior to establishment of the bi-directional broadband connection, the in-band modem in the net terminal associated with the one user terminal is configured to establish a preliminary communication with the controller to engage the controller to initialize one of the second xDSL modems for the bi-directional broadband connection (Col 9, L18-30).

c) Regarding claim 28, McHale et al. disclose a method in a telecommunication system for providing access to telecommunication services to subscribers at user terminals, each user terminal being coupled to one of plural net terminals, and each net terminal including an in-band modems and a first xDSL modem (30 in Fig. 1), and each net terminal being coupled to a first access point that includes a pool of second xDSL modems (74 in Fig. 2), comprising:

detecting a need to establish a bi-directional broadband connection between one of the user terminals and the access point (Col 8, L 21-31; Col 9, L 18-50; and Col 12, L 3-25);

establishing an initial communication from the in-band modem of the net terminal associated with one user terminal and a controller to initialize one of the second xDSL modems for the bi-directional broadband connection (Col 6, L45-47; and Col 9, L18-30);

in response to the initial communication, the controller configuring the first xDSL modem and one of the second xDSL modems to establish the bi-directional broadband connection between the user terminal and the first access point (Col 6, L45-47; and Col 9, L18-30).

d) Regarding claim 22, McHale et al. disclose an apparatus in a telecommunication system according to claim 21, wherein the in-band modem and the first xDSL modem and the first xDSL modem are configured to operate independently and in parallel in the net terminal (as shown in Fig. 1; Col 5, L 2-21).

e) Regarding claim 24, McHale et al. disclose an apparatus in a telecommunication system according to claim 21, wherein the pool of xDSL filters is located in the first access point (170 in Fig. 5).

f) Regarding claim 25, McHale et al. disclose an apparatus in a telecommunication system according to claim 21, wherein the pool of xDSL filters is located in a second access point coupled between the first access point and the controller (170 in Fig. 5).

g) Regarding claim 26, McHale et al. disclose an apparatus in a telecommunication system according to claim 21, further comprising:

a management system for processing retrieved user information so that the controller can adapt the established connection the retrieved user information (60 in Fig. 1).

h) Regarding claim 27, McHale et al. disclose an apparatus in a telecommunication system according to claim 21, wherein the controller is configured to retrieve subscriber information to individualize the established connection (Col 9, L 10-30).

i) Regarding claim 30, McHale et al. disclose the method in claim 28, wherein establishing the initial communication further comprises:

transmitting a signal from the in-band modem that includes a user terminal identity (Col 5, L49-56).

j) Regarding claim 31, McHale et al. disclose the method in claim 28, wherein after establishing the initial communication, the controller searches for an available connection path for the net terminal through the access point (Col 8, L 21-31; Col 9, L 18-50; and Col 12, L 3-25).

k) Regarding claim 32, McHale et al. disclose the method in claim 28, further comprising:

activating the bi-directional broadband connection between the user terminal and the access point (Col 8, L 21-31; and Col 12, L7-25).

l) Regarding claim 33, McHale et al. disclose the method in claim 28, further comprising to establish multiple bi-directional broadband connections with multiple user terminals (as shown in Fig. 1).

m) Regarding claim 34, McHale et al. disclose the method in claim 28, further comprising to establish simultaneously multiple bi-directional broadband connections with multiple user terminals (as shown in Fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,385,203 B2).

a) Regarding claims 23 and 29, McHale et al. disclose all the subjects above except for the specific teaching of a pool of xDSL filters.

However, it is well known that a xDSL modem must include filter for better signal qualities transmission. McHale et al. disclose xDSL modems in Fig.1. Therefore, it is obvious to one of ordinary skill in the art to recognize that there's a pool of xDSL filters in xDSL modems and signal is output to one of the second xDSL modems. By doing so, provide better signal transmission and modulation in the digital communication system.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 20 is provisionally rejected under the judicially created doctrine of double patenting over claim 7 of copending Application No. 09,741,741. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Regarding claim 20, a method in a telecommunication system for providing access to telecommunication services to subscribers at user terminals, each of which being separately connected to at least one access point, via a net terminal including an xDSL modems, and a communication network, the at least one access point comprising xDSL modems with filters, comprising:

transmitting a signal from an in-band modem of the net terminal including a user terminal identity to a controller;

in response, the controller searching for an available connection path for the net terminal at an access point.

creating, by the controller, a bi-directional broadband data transmission path between the user terminal and the at least one access point using the in-band modem connection of the net terminal for initial installation of the broadband data transmission path; and

activating, by the controller, the transmission path between the user terminal and the at least one access point.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eva Yi Zheng whose telephone number is (571) 272-3049. The examiner can normally be reached on 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on (571) 272-3056. The fax phone number for the organization where this application or proceeding is assigned is 703-879-9306.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

December 17, 2004

Eva Yi Zheng
Examiner
Art Unit 2634



**SHUANG LIU
PRIMARY EXAMINER**